

REMARKS

State of the Claims

Claims 1, 5, 6 and 9-15 are standing. Claim 1 has been amended per discussion with the Examiner during an interview held at the USPTO on Friday, October 29, 2004. Claims 16-54 have been canceled without prejudice. No new matter has been added.

35 U.S.C. § 101

Claims 1, 5, 6 and 9-15 stand rejected under 35 U.S.C. § 101 because, the Examiner states, the claimed invention is directed to non-statutory subject matter. Specifically, the claims are drawn to both an apparatus and the method steps of using the apparatus.

Applicants have amended Claim 1 such that the term "system" has been deleted and replaced with the term "method". Claims 5, 6 and 9-15 depend upon amended Claim 1. Applicants respectfully assert that Claim 1, rewritten as a method claim, is now in its proper form and therefore overcomes the Examiner's rejection.

Applicants therefore request reconsideration and allowance of Claims 1, 5, 6 and 9-15 over the Examiner's 35 U.S.C. § 101 rejection.

35 U.S.C. § 112 Rejection

Claims 1, 5, 6 and 9-15 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention.

Specifically, the Examiner notes that the claims are directed to an apparatus and the method steps of using same wherein it is not clear whether the claims are intended as apparatus claims or method claims. In addition, the additional limitation of 30 minutes makes Claim 1 unclear.

Applicants have amended Claim 1 to change the claim from a "system" to a "method" claim to clarify their intent. Also, Applicants have removed the 30 minute limitation formerly present in Claim 1.

Applicants therefore believe that all of the Examiner's concerns have been properly addressed and respectfully request reconsideration and allowance of Claims 1, 5, 6 and 9-15 over the Examiner's 35 U.S.C. § 112, second paragraph, rejection.

35 U.S.C. § 102(b) Rejection

Claims 1, 5, 6 and 9-15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Stover (U.S. Patent No. 4,579,048--hereinafter, Stover '048).

The Examiner states that Stover '048 discloses a system for preparing a customized brewed coffee beverage comprising structure allowing for delaying dilution of an extract for a time--e.g., 8 minutes.

According to MPEP § 2131 a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim. The elements must be arranged as required by the claim.

Applicants assert that Stover '048 is missing several elements claimed by Applicants. First, Stover '048 does not teach the dilution of coffee, only tea. In fact, Stover '048 draws a distinction between coffee and tea when it states "in making tea, the extract from the steeping operation will be too strong for regular consumption and be diluted, whereas the extract from typical coffee brewers is ready for consumption immediately [i.e., without dilution]."¹ [Emphasis added.] Furthermore, throughout the balance of Stover '048, the only dilution that is taught is for that with tea. Nowhere in Stover '048 is the dilution of coffee taught. One of skill in the art recognizes that though both tea and coffee may be brewed, brewing mechanisms for each may be highly varied. To sum up, Stover '048 is concerned only with the brewing of a tea concentrate, distinguishes itself from the brew of coffee, and does not teach the brew of a coffee concentrate.

In addition, Stover '048 does not teach Applicants' individualized customization which allows a consumer to customize a selection of coffee based upon his/her taste preferences.² Rather, Stover '048 provides only "completely automatic dilution means" thus implying no customer inputs for preference.³ In fact, Stover '048 plainly reveals that the operator (not customer) energizes an electrical circuit that "automatically controls the flow brewing and dilution water in the apparatus."⁴ Again, this dilution is for tea only and not coffee.

Without the dilution of coffee or individualized customization of coffee, Applicants respectfully assert that a proper case of Stover's novelty over Applicants' claims cannot properly be made.

¹ U.S. Patent No. 4,579,048 (Stover), col. 1, lines 54-57.

² Applicant's Specification, page 1, lines 13-15.

³ U.S. Patent No. 4,579,048 (Stover), col. 3, lines 26-27.

⁴ *Id.* at col. 5, lines 57-60.

Applicants therefore respectfully assert that Stover '048 is missing several key elements outlined above and request reconsideration and allowance of Claims 1, 5-6 and 9-15 over the Examiner's 35 U.S.C. § 102(b) rejection.

Claims 1 and 9-15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Adler (U.S. Patent No. 2,949,993--hereinafter, Adler '993). Claims 1 and 9-15 are pending.

Applicants assert that Adler '993 is missing several elements taught and claimed by Applicants. First, Adler '993 does not teach delayed mixing. Second, Adler '993 does not teach delayed filtering. In addition, Adler '993 does not teach the delay of dilution, mixing, and/or filtering of a coffee extract from between 5 minutes to 48 hours.

In addition, Adler '993 does not provide for strength customization of coffee which is included in the definition of an individually customized brewed coffee beverage. Applicant's brewed coffee is diluted according to the individual consumer's strength preferences.⁵ Such dilution based upon a consumer's strength preference is not taught by Adler '993. At best, Adler '993 teaches the addition of water for dilution purposes as "a proper quantity of hot water."⁶ Nowhere does Adler '993 teach that a consumer may determine the strength of his/her cup of coffee in order to individually customize that cup of coffee according to his/her strength preferences. In other words, every cup of coffee made by Adler '993 arrives at the exact same level of strength as every other cup without variation.

Given these missing elements, Applicants respectfully assert that their claims are now allowable over Adler '993 and request that the Examiner reconsider Claims 1 and 9-15 over the 35 U.S.C. § 102(b) rejection.

35 U.S.C. § 103 Rejection

Claims 1 and 9-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Adler '993.

The Examiner states that Adler's "extended time" of operation could be modified to encompass Applicants' time of operation (namely, from 5 minutes to about 48 hours) by one of skill in the art.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

⁵ Applicants' Specification, page 1, lines 21-22.

⁶ U.S. Patent No. 2,949,993 (Adler), col. 6, line 38.

combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all of the claim limitations.⁷

Applicants respectfully disagree with the Examiner's assertions. Applicants instead assert that Adler '993 fails to teach or suggest elements taught and claimed by Applicants. First, Adler '993 does not teach or suggest Applicants delayed filtering or delayed mixing. Second, Adler '993 does not teach or suggest Applicants' individualized customization of their coffee, and in particular the strength customization of their coffee. Put more plainly, Adler '993 does not teach or suggest a customer's ability to control the degree of dilution to affect the strength of that customer's cup of coffee. Adler '993 does not even consider this technical break-through.

Adler '993 merely provides the storage of coffee concentrate, creamer and other materials under vacuum to preserve its contents. Only the "proper quantity of hot water" is added to a cup of coffee by Adler '993 which is determined entirely by the machine pre-sets which are operator controlled rather than customer controlled. This is not Applicants' invention. Applicants assert that one of skill in the art looking at Adler '993 would not be motivated to make Applicants' invention because Adler '993 does not teach or suggest any of the elements noted hereinabove.

Therefore, Applicants respectfully assert that their claims are now allowable over Adler '993 and request that the Examiner reconsider Claims 1 and 9-15 over the 35 U.S.C. § 103(a) rejection.

⁷ In re Vaeck, 947 F. 2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

SUMMARY

The rejections in the Office Action have been discussed and, Applicants believe, the proper arguments have been set forth to address the rejections.

In light of the discussions contained herein, Applicants respectfully request reconsideration of the rejections and their withdrawal.

Issuance of a Notice of Allowance at an early date is earnestly solicited.

Respectfully submitted,

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